

**THIS DISPOSITION
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Hearing:
January 29, 2001

Paper No. 14
HRW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re IMP InterMediaPost Inc.

Serial No. 75/723,416

P. Jay Hines of Oblon, Spivak, McClelland, Maier & Neustadt, P.C. for IMP InterMediaPost Inc.

Cynthia Esparza Crockett, Trademark Examining Attorney, Law Office 111 (Craig Taylor, Managing Attorney).

Before Cissel, Hohein and Wendel, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

IMP InterMediaPost Inc. has filed an application to register the mark IMP INTERMEDIAPOST INTERNATIONAL MULTIMEDIA & POST PRODUCTION, in the format shown below, for "video editing, audio post production and multimedia production services for the entertainment and advertising industries in connection with the production of motion pictures, videos, commercials, infomercials and online

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advertising."¹ A disclaimer has been made of the words
"INTERNATIONAL MULTIMEDIA & POST PRODUCTION."

Registration has been finally refused under Section
2(d) of the Trademark Act on the ground of likelihood of
confusion with the mark INTERMEDIA, which has been
registered by Intermedia, Inc. for the goods and services
set forth in the following registrations:

Registration No.

1,849,813 ²	Prerecorded video cassette tapes, interactive laser discs, computer software programs, CD-ROMs and multimedia containing both live and animated action in the fields of drama, comedy, music, sports, documentaries, political and social issues, self help and instruction in a variety of disciplines.
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¹ Serial No. 75/723,416, filed June 7, 1999, based on an
allegation of a bona fide intention to use the mark in commerce.
An amendment to allege use was filed October 1, 1999, claiming a
date of first use anywhere and a date of first use in commerce of
June 2, 1999.

² Issued August 16, 1994, setting forth a date of first use
anywhere and a date of first use in commerce of January 1, 1986,
Section 8 & 15 affidavits accepted and acknowledged,
respectively.

1,926,904³ Production services, namely producing prerecorded video cassette tapes, interactive laser discs, computer software programs, CD-ROMs, and multimedia, containing both live and animated action, in the fields of drama, comedy, music, sports, documentary, political and social issues, self-help, and instruction in a variety of disciplines, and instructional manuals sold as a unit.

2,325,050⁴ Wholesale distributorship services and mail order catalog services featuring prerecorded video cassette tapes, computer software programs, CD-ROMs and multimedia containing both live and animated action in the fields of drama, comedy, documentary, political and social issues, self-help and instruction in a variety of disciplines.

The refusal has been appealed. Both applicant and the Examining Attorney have filed briefs and both participated in the oral hearing.

³ Issued October 17, 1995, setting forth a date of first use anywhere of November 15, 1980 and a date of first use in commerce of February 1, 1983, Section 8 & 15 affidavits accepted and acknowledged, respectively.

⁴ Issued March 7, 2000, setting forth a date of first use anywhere of November 15, 1980 and a date of first use in commerce of February 1, 1983.

We make our determination of likelihood of confusion on the basis of the *du Pont*⁵ factors that are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective goods and services, the Examining Attorney notes that registrant's goods and services encompass production services, namely, producing prerecorded video cassette tapes, interactive laser discs, computer software programs, CD-ROMs and multimedia, as well as the goods that are produced therefrom and the wholesale distributorship of these goods. The Examining Attorney then goes on to argue that the services of applicant and registrant are very similar; that both produce videos; that the production services of registrant are not limited in any way to "pre" or "post"; and that applicant's services in fact fall within the broad recitation of registrant's services.

⁵ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Applicant argues that the goods and services specified in the registrations do not encompass post-production services, such as are performed by applicant. Applicant describes its services as the refining and finalizing of motion pictures, commercials and the like for the entertainment and advertising industries. Applicant further argues that there is little chance for overlap in the marketplace in that applicant provides technical services to motion picture and advertising professionals, whereas registrant sells finished video tapes and other forms of media to schools, clinics and government agencies. Applicant has made of record specimens from registrant's registration files, as well as other materials which it asserts confirm the educational focus of registrant's video tapes and that registrant sells to schools, clinics and government agencies.

The issue of likelihood of confusion must be determined on the basis of the services as identified in the application and the goods and services specified in the cited registrations. *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In the present case, registrant's production services are broadly identified as "producing" video tapes and other media forms in various subject fields. From its

other registrations it is obvious that registrant also sells the finished products and performs distributorship and mail order services in connection with those products. From not only the production of goods such as video tapes, but also the ultimate sale of the same, it would appear that any post-production processes, such as "video editing" or "audio post production," would inherently be a part of registrant's production services. Thus, registrant's production services, as identified, encompass the specific post production services performed by applicant, despite applicant's arguments to the contrary.

Moreover, where there are no restrictions in the registrations as to channels of trade, we must assume that the registrant's goods travel in and its services are offered through all the normal channels of trade for goods and services of that nature. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). While applicant may have introduced evidence as to the specific markets in which registrant presently sells its video tapes and for which its tapes are produced, the registrations are not so limited. No distinction can be made on the basis of the present markets for registrant's goods or services, regardless of the specific limitations with respect to applicant's channels of trade. There is a

definite overlap of the specific channels of trade for the production services of the application with those encompassed by the goods and services of the cited registrations.

Thus, we turn to consideration of the similarity or dissimilarity of the respective marks being used with the goods and services at issue. In making our analysis of the marks, we are guided by the general principle that the greater the similarity of the goods and/or services, the lesser the degree of similarity of the marks which is necessary to support a conclusion that confusion is likely. See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). In particular, our focus here is based on the fact that applicant's specific services are encompassed by the more broadly identified services of registrant.

The Examining Attorney argues that the dominant portion of applicant's mark is the word portion INTERMEDIAPOST or, at other points, she refers simply to the term INTERMEDIA, and that, as such, applicant has merely appropriated registrant's mark INTERMEDIA and added the descriptive term POST.

Applicant, on the other hand, argues that the Examining Attorney has improperly dissected applicant's

mark. Applicant asserts that it is the letters IMP and the term MEDIA that are emphasized in its mark; that the coined term INTERMEDIAPOST is derived from the wording directly below it; and that the overall commercial impression of the mark is much more than the mere letter string INTERMEDIA. Applicant contends that the various components of its mark are tied together by the use of lower case script and the running together of the letters IMP and that consequently INTERMEDIA is part of a unitary phrase and does not create the separable impression of that term standing alone.

In making our likelihood of confusion determination, we are also guided by the principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more

likely to be remembered and relied upon by purchasers in referring to the services, and thus it is the word portion that will be accorded more weight in determining the similarity or dissimilarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

Applying these principles, we find the dominant portion of applicant's mark to be the term INTERMEDIAPOST. Clearly the matter below that term is purely descriptive in content, and has been acknowledged as such by applicant's disclaimer thereof. Furthermore, the design portion, which consists of the letters IMP, cannot be accorded as much weight as the word portion INTERMEDIAPOST, inasmuch as it would be the word portion that purchasers would rely upon in referring to applicant's services. If given any particular attention, the main function of the letters IMP would be to reinforce the word portion and the general impression created by the term INTERMEDIAPOST.

Thus, while admittedly there are differences in the appearance and sound of applicant's and registrant's marks as a whole, we find the overall commercial impressions very similar. The dominant portion of applicant's mark, the term INTERMEDIAPOST, is highly similar to the whole of registrant's mark INTERMEDIA. See *Hewlett-Packard Co. v.*

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Packard Press, Inc., No. 01-1276, slip op. at 7 (Fed. Cir. March 1, 2002) (even though defendant's mark PACKARD TECHNOLOGIES does not incorporate every feature of plaintiff's HEWLETT PACKARD marks, similar overall commercial impression is created.)

Furthermore, it is well settled that a subsequent user may not appropriate the mark of another and by adding subordinate or descriptive matter thereto avoid a likelihood of confusion. See *Henry I. Siegel Co., Inc. v. A & F Originals, Inc.*, 225 USPQ 626 (TTAB 1985); *Alberto-Culver Co. v. Helene Curtis Industries, Inc.*, 167 USPQ 365 (TTAB 1970). Here the term POST would most likely be viewed as descriptive of the post production feature of applicant's services. This descriptive significance is emphasized by the term POST PRODUCTION which appears directly below INTERMEDIAPOST. Thus, the INTERMEDIA portion of the term INTERMEDIAPOST would have the greater trademark significance and would be likely to lead to confusion with registrant's mark INTERMEDIA.

There are two exceptions to this general rule: (1) when the common portion is weak or descriptive or (2) when the marks in their entireties convey significantly different commercial impressions. See *In re Denise*, 225 USPQ 624 (TTAB 1985); 3 J.T. McCarthy, McCarthy on

Trademarks and Unfair Competition, §23:50 (4th ed. 2001). We find neither one applicable here.

Although applicant argues that registrant's mark INTERMEDIA is weak and not entitled to a broad scope of protection, we find that the evidence made of record by applicant does not establish such weakness. Applicant has submitted copies of six third-party registrations owned by five entities for marks including the term INTERMEDIA⁶ for various services including telecommunications services, cable transmission services, educational services in the field of communications and arranging trade shows with respect to various media technology products and services. None of those services involve any phase of the production of various media goods as do applicant's and registrant's services. Such registrations are not for similar marks for similar goods or services, so as to have an impact on the strength of registrant's INTERMEDIA mark.

In like manner, we find the evidence submitted by applicant of five trade names containing the term INTERMEDIA for Internet services to be irrelevant to the strength of registrant's mark for its production services and other closely related goods and services. Thus, we

⁶ We do not consider the mark INTERNETWORK MEDIA to be an INTERMEDIA mark.

find the common portion of applicant's and registrant's marks, the term INTERMEDIA, not to be weak or descriptive so as to bring the first exception into play. Nor do we find that the overall commercial impressions created by the terms INTERMEDIA and INTERMEDIAPOST are so distinctly different as would obviate any likelihood of confusion. Thus, the second exception is equally inapplicable.

Applicant has also raised the issue of the sophistication of the purchasers of the respective services and goods. Applicant argues that the typical buyer of registrant's video tapes is a school, clinic or government agency seeking a tape that is ready for viewing, whereas the typical buyer of applicant's services is a professional in the advertising or entertainment industry seeking assistance in the fine tuning and finalizing of motion pictures, videos, commercials or advertising.

As previously pointed out, however, no distinction can be drawn on the basis of the present markets for registrant's goods or services because the registrations are unrestricted as to channels of trade. Registrant's production services and the resultant furnishing of finished video tapes could be offered to the same purchasers as those for applicant's post production services, which also result in finished video tapes. While

these purchasers may be professionals in their particular fields, they are not immune to source confusion. This is especially true when the marks are very similar in commercial impression, as is the case here, and there is a definite overlap in the goods and services being offered thereunder. See *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992).

Finally, applicant argues that there has been concurrent use of the respective marks for over two years without any evidence of actual confusion. We can give little weight to this fact, however, under the present circumstances. In the first place, registrant has not had the opportunity to be heard from on this point. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984). Second, we have no information as to the extent of use of the respective marks or, in other words, whether there has been any real opportunity for confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). In any event, the relevant test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 14 USPQ2d 1849 (Fed. Cir. 1990).

Accordingly, weighing all of the relevant *du Pont* factors, we find confusion likely. To the extent that there may be any remaining doubt, we follow the well-

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established principle that any doubt regarding likelihood of confusion must be resolved in favor of the registrant. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal to register under Section 2(d) is affirmed.